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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,077	04/24/2001	Patrick Michael McCaffrey	ROC920010057US1-IBM 204	2562
7590	08/24/2004		EXAMINER	OJINI, EZIAMARA ANTHONY
Robert H. Berdo, Jr. RABIN & CHAMPAGNE, P.C. Suite 500 1101 14th Street, N.W. Washington, DC 20005			ART UNIT	PAPER NUMBER
			3723	
				DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/840,077	MCCAFFREY ET AL.
	Examiner	Art Unit
	Anthony Ojini	3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-9,21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-9,21,23-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Applicant's cancellation of claims 10-20 in Paper No. 11 and cancellation of claims 2,3,22,29 filed June 22, 2004 are acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, line 2, the phrase "**glass or ceramic-glass**" is unclear which limitation applicant is referring to.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-9, 21, 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Schweitzer et al.** (3,856,472) in view of **Kojima et al.** (3,990,990).

With respect to claims 1, 9, 21, Schweitzer et al. disclose a plurality of disks (5,6), stacked upon each other (see fig. 2). Schweitzer et al. also disclose each disk comprises a glass and a glass-ceramic.

Schweitzer et al. fail to disclose a plurality of fine, loose particles constituting a powder for facilitating removal of the first disk from the second disk, and protecting the first disk and the second disk **from scratches, and serving to cushion said first disk and said second disk to protect said disks from impact damage**, when the second disk is stacked upon the first disk.

Schweitzer et al. also fails to disclose the first disk is spaced apart from the second disk by only the powder.

Kojima et al. disclose a plurality of fine, loose particles constituting a powder for preventing adhesion substrate material to adjacent surfaces (see col. 1, lines 8-38 & claim 14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of Schweitzer et al with a powder disposed adjacent surfaces of the substrates in view of **Kojima et al.** so as to prevent the disks from sticking to each other.

With respect to claim 23, Schweitzer et al. fail to disclose a powder that spaces the first disk and from the second disk.

Kojima et al. disclose a plurality of fine, loose particles constituting a powder for preventing adhesion substrate material to adjacent surfaces (see col. 1, lines 8-38 & claim 14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of Schweitzer et al. with a powder disposed adjacent surfaces of the substrates in view of **Kojima et al.** so as to space and prevent the disks from sticking to each other.

With respect to claims 4-7 and 24-27, Schweitzer et al. disclose powder (form of mineral powder) comprising an inorganic material that is selected from the group consisting of calcium carbonate, magnesium carbonate (see col. 1, lines 13-19).

With respect to claims 8, 28, Schweitzer et al. fails to disclose wherein the powder has a size of about 200 mesh.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of **Schweitzer et al.** with powder that has a size of about 200 mesh **so as to firmly prevent adhesion between two surfaces**, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Amendment

Applicant's arguments filed 12/3/03 have been fully considered but they are not persuasive.

Applicant argues that "Initially, it is noted that Applicant's Petition, which was provisionally filed with the Response to Restriction Requirement on January 27, 2003, has not been forwarded to the Commissioner for review of the Examiner's Restriction". However, in response to Applicant's Provisional Petition to the commissioner, it is noted

that the rules do not provide such provisional petition because it appears the applicant is and has been prosecuting the case on the merit based on argument present by examiner for at least two non-final rejection actions. However, should Applicant wishes to forward to the Commissioner for review of the Examiner's Restriction, applicant should file a petition with fees directly to Commissioner so that decision could be made before any further prosecution.

Applicant argues that the U.S. Patent No. 3,856,472 to Schweitzer et al. "does not disclose or suggest a powder, much less a powder disposed between first and second stacked disks, as recited in claims 1 and 21". However, **Schweitzer et al.** disclose a concept of plurality of disks stacked upon each other that comprises a glass and a glass-ceramic.

Applicant argues that the U.S. Patent No. 3,990,990 to Kojima et al. "there is no disclosure or suggestion from this reference of using a powder to protect the first disk and the second disk from scratches, and/or which serves to cushion said first disk and said second disk to protect the disks from impact damage, when the second disk is stacked upon the first disk". However, disclose Kojima et al. disclose the concept of plurality of fine, loose particles constituting a powder for preventing adhesion substrate material to adjacent surfaces, that would inherently protect the substrate material surfaces from scratches, and serves to cushion the substrate material surfaces from impact damage, when the substrate material surfaces stacked upon the first disk.

Applicant argues "the cited references do not disclose or suggest a first glass or ceramic glass disk that is spaced apart from a second glass or ceramic glass disk by

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only a powder". However, Schweitzer et al. disclose disks comprising a glass and a glass-ceramic except only a powder that spaces the first disk and from the second disk.

Kojima et al. disclose a plurality of fine, loose particles constituting a powder for preventing adhesion substrate material to adjacent surfaces.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of Schweitzer et al. with a powder disposed adjacent surfaces of the substrates in view of **Kojima et al.** so as to space and prevent the disks from sticking to each other.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Ojini whose telephone number is 703 305

3768. The examiner can normally be reached on 7 to 4 Tuesday-Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703 308 2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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AO
August 19, 2004